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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,132	03/30/2000	Timothy Francis McDonough	CMCDO.00001	8936

7590 02/17/2004

Rudolph J. Buchel Jr.  
7113 Dobbins Drive  
Plano, TX 75025

EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/539,132

Applicant(s)

Mc Donough

Examiner

Feltner

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/19/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-155 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-155 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

1. This office action is in response to the amendment filed April 19, 2002, adding claims 144-155 and the personal interview with the applicant Timothy McDonough August 27, 2003. Claims 1-155 remain pending in the application and are presented to be examined upon their merits.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. The presented limitations are within the body of the claimed subject matter are based upon abstract ideas that can be carried out by a manual human process. This is a lack of technical basis because (see Ex Parte Bowman\*, 61 USPQ 2d 1665, 1671). It is therefore incumbent upon the applicant to present claim language within the body of the claim(s) that shows the use of technology performing one of more limitations. For example: instead of "receiving a bid order ..." you can say, "receiving a bid order into a **computer...**" (If a computer is the technology being used to perform the limitation). It is not enough for the preamble to cite "a data processing system..." The limitations within the **body** must provide language of technical basis. Failure to amend the claims in the manner explained about will be considered a non-compliant response to this office action.

Note: \*Although Bowman is not precedential Bowman is being cited for its analysis of whether the claim is in the technical arts.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 4,903, 201) in view of Denning et al., "Baltic Freight Futures: Random Walk or Seasonally Predictable? International Review of Economics and Finance 3(4) 399-428.

Wagner discloses as in claims 1, 11, 21, 26, 33, 40, 43, 44, 45, 55, 65, 70, 77, 83, 84, 88, 89, 100, 110, 120, 125, 139, 143, 144, 147, 148, 148, 149, 150, 151, 152, 155 a computerized exchange system receiving a bid order for a contract, wherein the bid order originates from the bidder;

Matching the bid order for the service with an ask order for a corresponding Service contract, wherein an asker owns the corresponding service contract, wherein an asker owns the corresponding service contract and ask order originates from the asker;

and transferring ownership of the corresponding service contract to the bidder (see Wagner, col. 5, ll. 5-30).

Wagner discloses a trading exchange system for transactions of futures commodity contracts but fails to disclose the exchange system for service contracts. Denning discloses that the Baltic International Freight Futures Market ("BIFFEX") is a futures market where the underlying asset is a service (see Denning et al. Introduction Page 399 and Conclusions on page 423). Since Denning suggests similarities between BIFFEX and the New York Stock Exchange (see Denning page 401, paragraph 2), it would have been obvious for an artisan of ordinary skill in the art to substitute the service contracts of BIFFEX for the commodity contract of Wagner because an artisan at the time of the invention would have recognized the benefits of an automated service contract futures exchange to conveniently provide efficient remote matching between large volumes of bidders and askers. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5771, or the examiner's supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

Response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-7687, for informal or draft communications, please label A Proposed or A Draft. Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file.  
PTO employees do not engage in Internet communications where there exists a

possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.



**DSF**

January 14, 2004



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